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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,492

01/09/2006

Theo Burchard

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03/24/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

1425 K STREET, N.W.

SUITE 800

WASHINGTON, DC 20005

EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

03/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,492	<b>Applicant(s)</b> BURCHARD, THEO	
	<b>Examiner</b> David J. Joy	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/10/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Examiner has agreed to examine the method and article claims together.  
  
However, if the method claims are significantly amended away from the article claims, such that different inventions are recited, the claims may be subject to a restriction requirement.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites that the two foils are to be

*exactly registered*, whereas in other claims, the phrase *in register* is recited to describe the alignment of the two foils (emphasis added). As it would be impossible to achieve absolute perfection in the registration of the two foils, it is unclear as to how the method step in Claim 6, namely the use of a tension group, can achieve this, as opposed to being able to achieve precise registry.

5. Claim 7 is rejected accordingly, as it depends upon Claim 6.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent of Edwards (5,093,184).

8. Edwards teaches a multilayer security element having two carrier foils that have security features thereon that only partially cover the foil, and that the carrier foils are

joined so that the security features are in precise register to each other (see Abstract; see also Figure 12; see also Column 2, Lines 1-27; see also Column 8, Lines 18-30). Edwards also teaches that the carrier foils have register marks, which are different features than the security features provided by the foils (see Column 2, Lines 11-48). Specifically, Edwards provides that the security element contains two metallic areas, which are visually detectable (*Id.*). Additionally, when the security element is viewed in reflected light, there is a repeating pattern along the length of the element that is visible and that appears to be in several different colors (see Column 2, Lines 11-48; see also Column 3, Lines 18-42; see also Column 4, Lines 14-28; see also ). Further, Edwards teaches that the multilayer security element can be a strip or thread, that the element is embedded within a security paper, and that the security paper can be used to make bank notes, checks, and other similar documents (see Abstract; see also Column 1, Lines 5-18 and 64-68; see also Column 4, Lines 60-63).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Edwards, in view of the U.S. Patent of Pollock (3,601,913) and/or the U.S. Patent of Solomon et al. (4,536,016; hereinafter "Solomon").

12. Edwards teaches a security element having a multilayer structure that contains at least two security features that are aligned so as to be in register with each other, and that the security features are used as register marks, in that it's the appearance of the two security features in visible windows that dictates the authenticity of the security element (see Abstract; see also Figure 12; see also Column 2, Lines 1-48). In addition, Edwards recites the degree of precision achieved through the assembly of the multilayer security element (see Column 2, Lines 28-48). Pollock, which is drawn to a

magnetic transaction card, and Solomon, which is drawn to banknotes, both provide additional details that can be used to make the multilayer structure in Edwards.

Pollock, teaches a method for producing a multilayer structure that having two security features ("layers of magnetic powder, M1 and M2) and register marks ("sprocket holes") which are integral in achieving the precise alignment of the multilayer structure (see Column 2, Line 62 – Column 3, Line 7). Pollock also teaches that the layers are assembled under a constant tensile stress, which is provided by pressure rollers, and that the register marks control the alignment of the layers as they move through the pressure rollers (*Id.*).

13. Solomon teaches that to make a security element made up of a multilayer structure, the structure having at least two carrier foils and register marks that appear in windows on the surface of the note (as was provided in the multilayer security element taught by Edwards), the basic steps of orienting the foils in both the transverse and longitudinal directions are necessary (see Column 2, Lines 34-49). Additionally, Solomon teaches that windows of the notes provide for the proper and precise alignment of the carrier sheets (see Column 4, Lines 27-40). In addition, with these windows acting as register marks on the surface of the multilayer structure, it is their presence that can be detected by a detector in order to ensure the precise registration as

well as make any adjustments to compensate for the any slight variations that might appear or as a result of the constant stretching (see Column 4, Line 65 - Column 5, Line 17). Finally, Solomon teaches that from the continuous web/roll of the multilayer structure, a completed security element (i.e., a bank note with the security device firmly bonded thereto) can be produced (see Column 5, Lines 18-29). As Edwards, Pollock and Solomon are all drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to make the multilayer security element taught by Edwards, and that given the end result recited by Edwards, the details provided by Pollock and/or Solomon could have been used in order to achieve that end result.

### *Double Patenting*

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated



by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

15. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

16. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 12-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-5, 16, 18-20 and 24 of copending Application No. 2005/0012326. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the copending application claims a multilayer security element having two foils that are aligned in register, and that the foils also provide additional security features (i.e., the gaps that are present) over that which is provided by the foils. The copending application also claims that the security element can be label or thread that is embedded in a security paper, and that the embedded security paper can be used to produce a document of value (i.e., a bank note). The difference between the copending application and that which is presently claimed is that the present claims feature "register marks" in the security element. However, the register marks are meant to provide additional security to the document, and the gaps/contours taught in the copending application provide the same feature.

18. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571)272-9056.

The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/  
Supervisory Patent Examiner, Art  
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/DJJ/  
Examiner, Art Unit 1794  
03/14/2008